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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,877	02/22/2002	Ronald A. Schachar	PRES06-00181	9828
	7590 09/03/2004		EXAMINER	
Docket Clerk P.O. Drawer 800889 Dallas, TX 75380			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 09/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,877

Applicant(s)

SCHACHAR ET AL.

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-61 is/are rejected.
- 7) ☒ Claim(s) 10-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/07/03, 10/28/02</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS 09/19/02</u> . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 1-21 and 31-61, in the reply filed on May 10, 2004 is acknowledged. The traversal is on the ground(s) that the surgical tool as set forth in claim 1 cannot be used for another purpose. Applicant asserts that Examiner has not convincingly provided another way of using the surgical tool. This is not found persuasive because Applicant's invention (as set forth in claims 1 and 31) does not necessarily need to be used in eye surgery (as set forth in claim 22). Examiner reasserts that the device as claimed can be used to clean plaque from the inside of a blood vessel. The only structural detail included in claims 1 and 31 is that the device has *a blade, a motor, and that it is capable of making a hole in the eye*. For example, U.S. Patent No. 6,443,966 B1 to Shiu and Publication No. 2003/0120295 A1 to Simpson et al. both are each surgical tools having a blade, a motor, and being capable of making a hole in the eye. However, both are meant for cleaning plaque from the inside of a blood vessel/artery/heart.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 39 and 51 are objected to because of the following informalities: The word "of" is misspelled in line 2 of both claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,522,829 to Michalos. Regarding Claim 1, Michalos discloses a surgical tool with a blade (22) capable of cutting the sclera of the eye [Fig. 1].
4. Regarding Claim 6, Michalos discloses a first drive shaft (26) coupled to base housing (12/14). Second drive shaft (20) is coupled (attached) to first drive shaft (26). Third drive shaft (28) is mounted on the drive shaft housing (12/14) at a 90-degree angle with respect to the central axis of the drive shaft housing. Surgical blade (22) is coupled to the third drive shaft (28).
5. Regarding Claims 7 and 8, Michalos discloses a device having a line, which will inevitably form the junction between section (14) and section (16) of the housing [see Attachment #1]. This line is *capable of being used as a reference line* during the surgery to guide him in cutting the eyeball.
6. Regarding Claim 9, Michalos discloses a rotatable support arm (32) with a first end coupled to drive shaft (28) and a second end coupled to blade (22) [Column 6, lines 10-14; Figure 1]. Support arm (32) rotates with the blade. The blade (22) has a curved end [Fig. 1] and another end coupled to support arm (32). The blade is quite sharp and is capable of being used to cut an incision having the specifications

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mentioned by Applicant. As noted by Michalos, the depth and size of the incision will correspond to the skill and desire of the surgeon [Column 8, lines 43-52].

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 and 31-61 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,328,747 B1 to Nun. Regarding Claims 1, 31, and 56, Nun discloses a surgical tool for making an incision in the eye and includes a surgical blade (246) [Fig. 18] capable of making an incision having the form of a pocket capable of receiving a prosthesis [Column 15, lines 61-63]. Surgical blade (70) is also capable of such a purpose [Fig. 14; Column 10, lines 42-52]. An incision is considered to be merely a cut or hole in body tissue. Nun discloses putting a prosthesis into the eye [Column 16, lines 6-8].
8. Regarding Claim 2, blade (70) is curved [Fig. 14; Column 10, lines 46-50] and the user of the device can cut as small or as big incision as the user desires. Particularly, the blade 246 (when it is not spinning) *is capable of being used* to puncture the sclera and form a very small, linear incision in the sclera.
9. Regarding Claims 3, 32-34, 42-43, 48-50, 54, 55, and 57-61, Nun discloses a first drive shaft (248), a drive motor (206), and a control cable (not shown) [Fig. 16; Column 17, lines 23-26 and 48-51; Column 12, lines 1-3]. Drills are generally capable of bi-directional spinning. Electric power comes from an external power

source (i.e., electricity) so there would need to be a receptacle to allow the electricity to flow into the motor [Column 17, lines 48-54].

10. Regarding Claims 4, 35-38, 44, and 45, the surgeon can adjust the speed of the motor using controls [Column 15, lines 36-40].

11. Regarding Claims 5, 39-41, and 51, Nun discloses a foot switch for controlling the speed of the blade [Column 20, lines 59-62]. Foot switches are capable of receiving control signals from the surgeon, such as depressing the pedal in order to tell the motor to rotate faster.

12. Regarding Claims 46, 47, 52, and 53, Nun's device is capable of rotating the blade once (in a controlled way) in order to make an incision.

Allowable Subject Matter

13. Claims 10-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Publication No. 2004/0073303 to Schanzlin et al.

U.S. Patent No. 6,602,266 B1 to Loomas et al.

U.S. Patent No. 6,565,584 B1 to Mathis et al.

U.S. Patent No. 6,117,149 to Sorensen et al.

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U.S. Patent No. 6,051,009 to Hellenkamp et al.

Publication No. 2002/0077642 to Patel et al.

U.S. Patent No. 4,071,029 to Richmond et al.

U.S. Patent No. 6,610,075 B1 to Levesque et al.

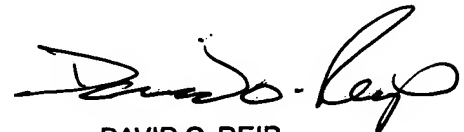
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaver or McDermott can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP
BCP

August 25, 2004



DAVID O. REIP
PRIMARY EXAMINER